

REMARKS

This is a response to the Office Action of October 3, 2006. In the outstanding Office Action, the Examiner issued a restriction requirement between claims 1-8 and 16-20 (Group I), claim 9 (Group II), claims 10, 11 and 15 (Group III), claims 12 and 13 (Group IV), and claim 14 (Group V).

Applicant elects the claims in Group III, that is claims 10, 11, and 15 with traverse for the reasons enumerated below.

Claims 10, 11, and 15 have been amended for reasons of form. Additionally, new claim 21 has been added, directed to a process for producing a synthetic resin emulsion; new claim 21 is believed to correspond to the claims in Group III because it is also directed to a method for making a synthetic resin emulsion. No new matter has been added by amendment. Specifically, the amendments and new claim 21 are supported by the original claims, at page 15, lines 10-27, page 3, lines 22-26, page 4, lines 4-14, and Example 1.

The Examiner issued a restriction requirement between the pending claims, reasoning that they do not relate to a single inventive concept under PCT Rule 13.1 because they lack the same or corresponding technical features. In support of this statement, the Examiner argued that the claims do not have a corresponding special technical feature under Rule 13.2 because the claims lack patentability over, US Patent No. 5,081,166 or EP 555959. Specifically, the Examiner stated:

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1, at least, is anticipated by or obvious over US 5081166 or EP555959. Consequently, the special technical feature which links the claims, the synthetic emulsion, does not provide a contribution to the prior art, and so unity of invention is lacking.

The restriction requirement between the claims is believed improper under applicable law, and should be withdrawn.

As stated in Rule 13.2, "the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." Annex B of the Administrative Instructions, provides the following additional guidelines when determining unity of invention:

(i) If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim avoids the prior art and the combination claim includes all the features of the subcombination.

(ii) If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity *a posteriori* (that is, arising only after assessment of the prior art) may be raised. Similar considerations apply in the case of a genus/species or combination/subcombination situation.

(iii) This method for determining whether unity of invention exists is intended to be applied even before the commencement of the international search.

Where a search of the prior art is made, an initial determination of unity of invention, based on the assumption that the claims avoid the prior art, may be reconsidered on the basis of the results of the search of the prior art.

The Examiner's reason for restricting the claims is manifestly erroneous based on the above guidelines. As is evident in subparagraph (ii) of the guidelines, a restriction may be proper between (a) one independent claim which lacks contribution over the art, and (b) one independent claim which positively contributes over the prior art. However, in the present case, the Examiner is restricting between claims which share the same feature that is alleged to be unpatentable—the synthetic resin emulsion. Thus, even assuming *arguendo*, that the synthetic resin emulsion (which all claims have in common) does not contribute over the art, a restriction would still be improper because all the claims incorporate that feature in any event. After all, if the synthetic resin emulsion does not contribute over the prior art in any of the claims, the Examiner should issue a rejection over the art referred to above, rather than restricting the claims five separate ways. In this regard, Applicant submits that at least Groups I and III should be examined together due to the similarity of the claimed subject matter.

Furthermore, Applicant submits that the references which were noted by the Examiner, US 5,081,166 and EP 0555959, are not remotely suggestive of the invention that is claimed in the pending application and, therefore, do not support the Examiner's assumption underlying the restriction requirement. For example, unlike the claimed invention, the '166 reference only teaches to adjust the pH after both the core and the shell portions are polymerized. See, Example 1 of the '166 reference, and col. 12, lines 17-22. Likewise, the European '959 reference also indicates that the emulsion polymer may be neutralized only *after* it is fully polymerized as is seen, for example, at page 5, lines 22-23, and lines 29-30 of that reference. The art noted by the Examiner is not at all suggestive of the claimed invention because the inventive resins are produced by adding the core monomer component to the copolymer solution when the copolymer is in an unneutralized state, and then *concurrently* neutralizing the resin while polymerizing the core components. See, page 15, lines 10-27, of the pending application. In this manner, the water swellable attributes of the inventive resins are superior, it is believed, because the hydrophilic component is incorporated better into the polymer. Thus, the claims contribute

to the technical field over the prior art, and share a common special technical feature—namely, the synthetic resin emulsion. Restriction between the claims is, therefore, improper.

In any event, Applicant is entitled to claim a reasonable number of species provided that there is not an undue burden as to search and examination. Applicants respectfully request that the *Restriction Requirement* be reconsidered as it is not shown in the Office Action that a serious burden would be required to examine the pending claims together in the instant patent application. *See*, MPEP § 803.

This response is believed timely filed. However, if any additional extensions are required, please consider this paper a *Petition* thereof and charge our Deposit Account No. 50-0935. Please charge any applicable fees for the additional claim to our Deposit Account No. 50-0935.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Aaron Webb', is positioned above the printed name and registration number.

Aaron Webb  
Reg. No. 56,930

Ferrells, PLLC  
4400 Fair Lakes Court, Suite 201  
Fairfax, VA 22033-3899  
Telephone: (703) 968-8600  
Facsimile: (703) 968-5500  
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